

### REMARKS

This is a full and timely response to the non-final Official Action mailed **September 12, 2003** (Paper No. 3). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, claims 1, 11, 17-19, 21 and 22 have been amended.

Additionally, new claims 23-59 have been added. No original claims have been cancelled.

Thus, claims 1-59 are currently pending for the Examiner's consideration.

With regard to the prior art, the Office Action rejected claims 1, 11 and 17 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,282,092 to Wilhelms ("Wilhelms"); and claims 1-5, 7-13, 15-19, 21 and 22 as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,331,011 to Kuroda et al. ("Kuroda"). Claims 6, 14 and 20 were rejected under 35 U.S.C. § 103(a) over Kuroda in view of Official Notice taken by the Examiner. For at least the following reasons, these rejections are respectfully traversed.

In a telephone interview with the Examiner on December 5, 2003, Applicant's attorney (the undersigned) discussed with the Examiner the Wilhelms and Kuroda references. In particular, Applicant's attorney pointed out that Kuroda does not teach or suggest recording a portion of an audiovisual program that was output *before* a user enters a record command.

As described in Col. 5, Kuroda teaches that when a viewer gives the video recorder/player a record command, the recorder/player *then* begins recording. (Col. 5, lines 12-15). The recorder/player then asks for user input regarding the recording being made.

(Col. 5, lines 16-33). The recorder/player then merges the recording made while the user was inputting recording parameters with the recording made after the user input the parameters. However, *all* recording is done only *after* the user enters the initial record command.

In contrast, claims 1, 11 and 17 all recite that some portion of the audiovisual program that has already been output before the user enters a record command is buffered and captured in response to the user record command. Thus, the resulting recording includes portions of the audiovisual programming that both preceded and followed entry of the record command by the user.

Upon considering this argument in the telephone interview of December 5, 2003, the Examiner agreed and stated that the Kuroda reference had been “overcome.” Consequently, Applicant understands that the rejection based on Kuroda will be withdrawn and notice to that effect is respectfully requested.

Following withdrawal of the rejection based on Kuroda, the only remaining rejection in the Office Action is the rejection of claims 1, 11 and 17 based on Wilhelms. No rejection remains as to claims 2-10, 12-16 and 18-21.

With regard to the Wilhelms reference, claim 1 recites:

A personal video recorder having a user-controlled data capture function, the recorder comprising:

an input for receiving an audiovisual signal and an output for outputting said audiovisual signal;

a buffer for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder;

a data storage unit; and

a processor that receives input from a user input device;

wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising:

a first predetermined amount of said portion of said audiovisual signal retained in said buffer, wherein said first predetermined amount is less than all of said portion of said audiovisual signal retained in said buffer; and

a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command.  
(emphasis added).

Similar recitations are found in claims 11 and 17. Support for the amendments made herein to claims 1, 11 and 17 can be found in the specification as originally filed at page 8, line 26 *et seq.*

In contrast, Wilhelms fails to teach or suggest that less than all of the buffered audiovisual signal is saved in response to a user record command. As explained by Wilhelms in col. 4, lines 9-14, all the data in the buffer is always saved in response to a user record command.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, the Wilhelms reference no longer anticipates claims 1, 11 and 17. Therefore, the rejection based on Wilhelms should be reconsidered and withdrawn.

The newly added claims are thought to contain patentable subject matter for the following reasons. The newly added claims mostly recite subject matter which was previously rejected in reliance on the Kuroda reference. For example, new claim 23 corresponds to claim 8, new claim 30 corresponds to claim 2, and new claim 42 corresponds to claim 5. Since Kuroda has been demonstrated as inapplicable to these original claims, the newly added claims are also thought to be clearly patentable over the prior art of record.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



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